

REMARKS

Claims 1 and 3-16 are pending in the present application.

Issues under 35 U.S.C. §§ 102(a) and 103

Claims 1, 3, 5, and 7-9 have been rejected under 35 U.S.C. § 102(a)/103 as being anticipated by or obvious over EP '701. Claim 6 is free of this rejection. Claim 10 has been rejected under 35 U.S.C. § 103(a) as being obvious over EP '701 combined with WO 97/34196 (hereinafter referred to as "WO '196") and EP 021433 (hereinafter referred to as "EP '433"). Claims 4 and 6 have been rejected under 35 U.S.C. § 102(b)/103(a) as being anticipated by or obvious over EP '433 or WO '196.

The present invention is most broadly encompassed by claim 1, which recites a thermally processed image forming material containing elsewhere on a support a reducing agent, a binder and non-photosensitive fatty acid silver salt grains wherein the non-photosensitive fatty acid silver salt grains are prepared by mixing and reacting a silver ion-containing solution, the solvent of which is water or a mixture of water and an organic solvent, with a solution of a fatty acid alkali metal salt, the solvent of which is water, an organic solvent, or a mixture of water and an organic solvent, in a closed mixing means.

Thus, the present invention is drawn to a product, which is defined by the process by which it is made. Specifically, the product of the present invention requires the presence of non-photosensitive fatty acid silver salt grains that are prepared by mixing and reacting a silver ion-containing solution and a solution of a fatty acid alkali metal salt in a closed mixing means. With the present invention, the use of a closed mixing means results in a different and superior product than that of the prior art.

As noted above, present claims specifically require that the product be made using a closed mixing means. EP '701 discloses the use of conventional methods, i.e. open mixing, for producing non-photosensitive fatty acid silver salt grains. By using the recited process of claim 1, the resulting product has unique properties compared to the product of EP '701.

In the response of September 11, 2002, Appellant submitted under 37 C.F.R. § 1.132, a Declaration of Inventor Shoji YASUDA. The remarks from the Appeal Brief discussing this Declaration are herein incorporated by reference.

Thus, Applicant has shown that the product of the present invention, when prepared in accordance with the recited process, possesses distinct properties that distinguish the product of the invention from that of EP '701. As such, the product of the present invention, which is different from the product of EP '701, due to the process used to make the product, is not anticipated by

the reference. In addition, the present product possesses unexpected advantageous properties compared to the product of EP '701, such that the present product is not obvious over the disclosure of EP '701.

The Examiner alleges that the experiments of the September 11, 2002 Declaration were insufficient to overcome the rejection over EP '701 because only the organic silver salt dispersion of EP '701 was used in the comparison instead of the total photothermographic material of EP '701.

As noted in the response of July 28, 2003, based on the Examiner's comments, Mr. YASUDA has performed additional experiments, which are presented in the attached Declaration submitted under 37 C.F.R. §1.132. In the experiments of the Declaration, Mr. YASUDA compared a photothermographic material of Example 1 of EP '701 to the same photothermographic material, with the exception that Dispersions B and C of page 80 of the specification were used in place of Organic Silver Salt Dispersion A of the reference. Dispersions B and C were prepared in a closed mixing means.

The results of the experiments, which are presented in the Table on page 2 of the Declaration, show that photothermographic materials containing non-photosensitive fatty acid silver salt grains prepared in a closed mixing means have superior sensitivity and surface properties compared to the same photothermographic

materials containing non-photosensitive fatty acid silver salt grains prepared in an open mixing means.


In preparing the photothermographic materials, Mr. YASUDA used the Spectral Sensitizing Dye "B" of page 106 of the specification in all of the samples, in place of Spectral Sensitizing Dye A of page 22 of EP '701. However, as stated on page 3, first paragraph of the Declaration of Mr. YASUDA, the superior results demonstrated with the invention are independent of the particular sensitizing dye used and would be expected regardless of the sensitizing dye used in the material. Thus, the use of Spectral Sensitizing Dye "B" instead of Spectral Sensitizing Dye A, is an irrelevant modification that does not impact the improved properties observed with the invention compared to EP '701. As such, the present invention possesses unexpected improved properties, which are in no way disclosed or suggested by the prior art references. The present invention is therefore not obvious over the prior art and withdrawal of the rejections is respectfully requested.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Enclosure: Declaration of Mr. YASUDA, executed August 11, 2003